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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
09/960,291	09/24/2001	Patrick D. Boyd	219.40236X00	4764
7590	10/13/2004			
Schwegman Lundberg Woessner & Kluth			EXAMINER	/
P O Box 2938			TRINH, MINH N	
Minneapolis, MN 55402			ART UNIT	PAPER NUMBER
			3729	

DATE MAILED: 10/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/960,291

Applicant(s)

BOYD ET AL.

Examiner

Minh Trinh

Art Unit

3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 11-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I invention (claims 1-10 and 20-29) in the reply filed on 8/9/04 is acknowledged. However, upon further review species 1A and species 1B, claims 1-10 and 20-23. The Examiner agreed that claims 1 and 20 are generic claims. Therefore, the requirement of species election set forth in prior action paragraph 2 is hereby withdrawn. Thus, claims 11-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 8/09/04.

An office action on the merits of claims 1-10 and 20-23 as follows:

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-10 and 20-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

the claims directed to "a slot holder" (see preamble claims 1 and 20) however claims also directed to an outside element such as "a card edge slots having plurality of pin . . ." (claims 1 and 20, line 2-3, etc.) which makes the scope of claims unclear.

It is not clear whether "a card slot" (claim 2, line 2) is part of "a slot holder".

The phrase "... is passed over a wave solder machine ..." (claim 6, lines 3) does not seem to further limit the claimed structure. Also, such outside structure that makes scope of the claims unclear.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6 and 20-23 as best understood are rejected under 35 U.S.C. 102(b) as being anticipated by Cauceglia et al (4,223,934).

As applied to claims 1 and 20, Cauceglia et al disclose a slot holder comprising: a plurality of slot insertion members 15 to hold a plurality of card edge slots 11 having plurality of pin extending from each of the plurality card edge slots in alignment for insertion of the plurality of pins into a plurality of holes of a printed circuit board (see Figs. 1-2); at least one grip attachment member 27 connected to the plurality of slot insertion members to rigidly hold the plurality of slot insertion member in a fixed position (see Fig. 2); and at least one grip member connected to the at least one grip attachment member 22 to enable the holding and positioning the slot holder (see Fig. 2).

Limitation of claim 2 is also met by Cauceglia et al (see Fig. 2, shows a card slot 11 having a plurality of electrical contact points associated therefrom).

As applied to claims 3-4 and 20, Cauceglia et al disclose at least two grip attachment members that associated with at least two grip members (see Fig. 2, references 22 and 21, Figs. 7 and 9).

Limitations of claims 5-6, 22 and 23 are also met by Cauceglia et al since there is no structural different between the slot holder of the application compare to the applied prior art therefore, the prior art is capable for use in a wave solder machine as recited in the application claims (see claims 6 and 22, line 3).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7-10 as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Cauceglia et al.

Regarding limitation of claims 7-10, it is noted that Cauceglia et al inherently disclose the limitations of these claims i.e., that it is known to the art that slot member having insertion points that is extending into the card slot.

Limitations of claims 8-10 are also met as discussed above.

Conclusion

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8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art references cited for their teaching of slot holder tool for PCB or the like.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (703) 305-2887. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Minh Trinh 10/08/04
Primary Examiner Group 3700

mt